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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,911	11/21/2003	Bryan M. Kelly	BLLYP001.US13	4013

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TIPS/BALLY
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EXAMINER	
HSU, RYAN	

ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
08/22/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/719,911	KELLY ET AL.	
	Examiner	Art Unit	
	RYAN HSU	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 June 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

In response to the Request for Continued Examination (RCE) under 37 CFR 1.114 filed on 6/30/08. In response to the amendments filed on 6/30/08, claims 1-2, 5, and 8-9 have been amended. Claims 1-12 are pending in the current application.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. However, Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original non-provisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 07/956,057, 08/176,862, 08/995,649, 09/351,408, 09/695,712, and 10/176,100 fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The applications previously filed do not disclose or suggest or mention the use of "a CPU" to provide awards based on one or more criteria wherein the award server includes "a CPU a software, physically separated from said plurality of player machines and coupled with said plurality of player-machines for digital communication therewith, wherein

said digital communication includes game information and award information associated with said at least one game".

Claim Objections

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The claims identify a gaming machine and method that calls for a "CPU" which is critical or essential to the practice of the invention. However the specification has no mention of a "CPU". It is unclear what the applicant is associating with the support for this feature. The closest recognizable term that appears in the specification is a "microprocessor" which has not been identified as a CPU. In the computing arts a CPU is typically identified as a central processing unit, however the applicant's specification is only directed towards a microprocessor which does not encompass the same scope as that of a central processing unit.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida (US 4,964,638 A) and further in view of Johns (US 2,926,915).

Regarding claims 1 and 8-9, Ishida teaches a game system comprising: a plurality of physically separated player-machines, wherein each physically separated player-machine includes its own CPU and software for allowing a player to play at least one game that request sufficient skill wherein the player is entitled to play of at least one game due to an economic consideration and is adapted for developing digital information resulting from play of the at least one game. Additionally, Ishida teaches a bonus apparatus including a CPU and software, physically separated form the plurality of player-machines and coupled with the plurality of player-machines for digital communication therewith, wherein the digital communication includes game information and award information associated with the at least one game.

However, Ishida is silent with respect to an embodiment where the game is not typically referred to as a "game of chance". However, it could be stated that all games have an element of chance that are inherent within them. By the same interpretation typical "games of chance" also require "sufficient skill" to play (*ie: poker or counting cards in ' blackjack'*). It is also noteworthy to mention that the embodiment disclosed in applicant's own invention of a 'roll down' game also is well known in the art and while it may take 'skill' as contested by the applicant's representative also'incorporates' an element of chance as once the ball is released it is left up to chance on which score the player will receive. Nevertheless, in an analogous gaming patent, Johns teaches a automatic ticket-dispensing ball machine that teaches the well known elements of awarding a non-monetary value and a machine that is what the applicant claims to be a non-game of chance (*see Fig. 1-9 and the related description thereof*). Johns teaches the

elements of the game machine as well as an award device (*ie: tickets*) (*see Fig. 1-9 and the related description thereof*). Ishida's game machine teaches the incorporation of providing various types of games that can be linked to the progressive system and one would be motivated to incorporate a game such as that taught in Johns in order to provide a player with various options and different games that could be played. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ishida with that of Johns in order to provide a progressive game system that incorporated non-games of chance.

Regarding claims 2 and 10, Ishida teaches a system wherein the digital communication is over a network wherein the plurality of player-machines is coupled to the bonus apparatus (*see Fig. 1 and the related description thereof*).

Regarding claims 3-4 and 11-12, Ishida teaches a system wherein the network includes various options to allow for networked communication between the different devices. As taught by Ishida, pluralities of player-machines are connected through a serial communications system that pass and communicate using serial codes (*see col. 6: ln 50-col. 7: ln 5*). Therefore Ishida teaches a system wherein the network communication device inherently uses a common serial transmission protocol and thus it would encompass implementation of the standard protocol known as RS-232 (*see col. 6: ln 8-col. 7: ln 26*).

Regarding claim 5, Ishida teaches an bonus apparatus that provides awards based on one or more criteria, selected from a group consisted of: a game result; a progressive score; a completion of a specific task; an attainment of a specific goal; and a number of players playing (*see col. 3: ln 1-col. 4: ln 50*).

Regarding claim 6, Ishida teaches a game system wherein the progressive score is associated with a progressive bonus that is based on contributions made by a plurality of physically separated player-machines, and wherein the progressive score can be incremented or decremented based on a multiplier associated with the contributions (*see col. 4: ln 20-col. 5: ln 20*).

Regarding claim 7, Ishida teaches a game system wherein the contributions are based on one or more events comprising: consideration generated from at least one of the plurality of physically separated player-machines (*see col. 4: ln 35-col. 5: ln 27*); and attainment of at least one of the plurality of physically separated player-machines; and attainment of at least one pre-determined goal by at least one player playing at the plurality of physically separated player-machines (*see col. 5: ln 30-col. 6: ln 25*).

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communication from the examiner should be direct to Ryan Hsu whose telephone number is (571)-272-7148. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E Pezzuto can be reached at (571)-272-6996.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll-free).

RH

August 15, 2008

/Robert E Pezzuto/

Supervisory Patent Examiner, Art Unit 3714